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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/539,884

06/16/2005

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EXAMINER

BODAWALA, DIMPLE N

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

12/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/539,884 | | YAMAGUCHI ET AL. | |
| | Examiner | | Art Unit | |
| | Dimple N. Bodawala | | 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9,13,19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) 2-8,10-12,14-18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9,13,19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 2-8, 10-12, 14-18, and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 22, 2007.
2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

3. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country. Applicant claimed the priority benefit of PCT/JP03/15923, but applicant did not submitted oath or declaration form with claimed data of PCT application (See Bib-data sheet).

4. Receipt is acknowledged of papers foreign document JP 2002-363770 submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

5. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in JAPAN on December 12, 2003. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Oath/Declaration

6. Applicant has not given a post office address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration. A statement over applicant's signature providing a complete post office address is required.

7. Bib-data sheet is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d) based on an application filed in Japan on December 12, 2003. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath, declaration or application data sheet does not acknowledge the filing of any foreign application. A new oath, declaration or application data sheet is

required in the body of which the present application should be identified by application number and filing date.

Specification

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 9, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 1 is vague and indefinite because it is unclear which part of the synthetic resin molding is so constructed and is so coupled with an anodic oxidation coating.

12. Claim 1 further vague and indefinite because it is unclear which thing is being intruded in the innumerable pores of the coating.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 9, 13, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by JP (2002-302795); which is cited by Applicant on PTOL-1449.

15. JP (2002-302795) discloses a surface treatment device which comprises a resin film is carried out to the surface treatment aluminum material which has the anodic oxide film (See paragraph 14 of the translation); anodic oxide film which is formed in the front face of the aluminum or an aluminum alloy, wherein the anodic oxide coating film having pores (See paragraph # 6 of the translation), and wherein the pores having a diameter of 50-200 nm (See paragraph # 8 of the translation), which could be understandable of 25 nm or more as defined in claim 1.

16. Here claims 9, 13, 19 and 21 are claimed a product which is produced by different method, while claim 1 is claimed an apparatus. As we know with respect to the claim recitation regarding the method of forming the apparatus, such relate only to the method of producing the claimed

apparatus, which does not impart patentability to the apparatus claim. Note that determination of patentability is based on the product apparatus itself, *In re Brown*, 173 USPQ 685, 688, and the patentability of a product does not depend on its method of production, *In re Pilkington*, 162 USPQ 145, 147; *In re Thorpe*, 227 USPQ 964 (CAFC 1985). Note that it is Applicant's burden to prove that an unobvious difference exists, *In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983), and Applicant must show that different methods of manufacture produce articles having inherently different characteristics, *Ex parte Skinner*, 2 USPQ2d 1788, See MPEP 2113.

17. Thus, JP (2002-302795) discloses all claimed structural limitations as discussed above, and, thus, the claims are anticipated.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims 1, 9, 13, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP (2001-172795), which is cited by Applicant on PTOL-1449 in view of Kataoka et al. (U S Patent No. 5,866,025).

22. JP (2001-172795) discloses a surface treatment device which comprises a composite of an aluminum material and composite article having an anodic oxidation coating film (See paragraph 1 of the translation). It further discloses a semiconductor fabrication machines or other techniques which

could be understandable to have a synthetic resin material. It further teaches that the anodic oxidation coating comprising innumerable pores in the surface of the aluminum material, but fails to teach the diameter of the innumerable pores.

23. In the analogous art, Kataoka et al. ('025) discloses a mold for synthetic resin molding comprises a base mold having a metal, wherein a metal is selected from the aluminum material (See abstract; col.4 lines 30-35) and cavity is coated with insulating layer (See abstract). It further teaches that the metal base (1) is coated with the insulating layer (2, 9), wherein the insulating layer comprises a large numbers of pores (10) (See col.26 lines 42-50), wherein the pores (10) having a diameter of 0.2 mm (See example 1), which could be understandable to have a diameter of the pores more than 25 nm as defined in claim 1 of the instant application.

24. Here claims 9, 13, 19 and 21 are claimed a product which is produced by different method, while claim 1 is claimed an apparatus. As we know with respect to the claim recitation regarding the method of forming the apparatus, such relate only to the method of producing the claimed apparatus, which does not impart patentability to the apparatus claim. Note that determination of patentability is based on the product apparatus itself,

In re Brown, 173 USPQ 685,688, and the patentability of a product does not depend on its method of production, *In re Pilkington*, 162 USPQ 145, 147; *In re Thorpe*, 227 USPQ 964 (CAFC 1985). Note that it is Applicant's burden to prove that an unobvious difference exists, *In re Marosi*, 218 USPQ 289, 292-293 (CAFC 1983), and Applicant must show that different methods of manufacture produce articles having inherently different characteristics, *Ex parte Skinner*, 2 USPQ2d 1788, See MPEP 2113.

25. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the invention of JP (2001-172795) providing a diameter of pores more than 25 nm which is enough for discharging gas in the mold cavity during the surface treatment (See col.28 lines 37-44) as suggested by Kataoka et al. ('025).

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTOL-892 for further references related to synthetic resin molding).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dimple N. Bodawala whose

Application/Control
Number: 10/539,884
Art Unit: 1791

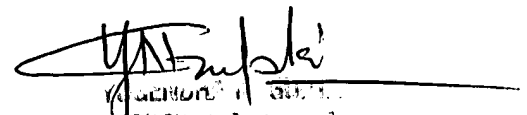
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telephone number is (571) 272-6455. The examiner can normally be reached on Monday - Friday at 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra N. Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DNB


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